

Application No: 10/733,343
Attorney's Docket No: ALC 3108

REMARKS/ARGUMENTS

Claims 1-16 are pending in this application. Claims 1, 5, 12, 13 and 15 are independent. Claims 1, 5 and 13 are hereby amended.

In paragraph 23 on page 8, the Office Action indicates that claims 5, 6, 8 and 10 are allowed. Nevertheless, claim 5 is amended to correct minor typographical errors.

Examiner Coleman is thanked for telephone interview conducted on October 10, 2006. The following constitutes Applicant's record of the substance of the interview. Applicant requested that Examiner Coleman indicate the subject matter recited in claim 5 giving rise to the allowance of claims 5, 6, 8 and 10. In response to this request, Examiner Coleman indicated that the recitations in claim of a channel state RAM and a channel register were the portions of claim 5 that gave rise to the allowance of claims 5, 6, 8, and 10.

In paragraphs 2-11 on pages 2-5, the Office Action rejects claims 1-4, 7, 9, 11, 13 and 14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,288,656 to Desai in view of U.S. Patent No. 5,003,558 to Gregg and U.S. Patent No. 6,959,297 to Oh et al. (hereinafter "Oh"). This rejection is respectfully traversed.

Claims 1 and 13, from which claims 2-4, 7, 9, 11 and 14 depend, respectively, recite, "a channel state RAM for storing the state of the processor and running C times slower the data rate." As discussed above in connection with the telephone interview conducted October 10,

Application No: 10/733,343
Attorney's Docket No: ALC 3108

2006, regarding the allowance of claim 5, this subject matter in combination with the other subject matter recited in the rejected claims, renders the claims allowable.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-4, 7, 9, 11, 13 and 14 in paragraphs 2-11 on pages 2-5 of the Office Action be withdrawn.

In paragraphs 12-17 on pages 5-7 the Office Action rejects claims 15 and 16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Desai in view of Oh. This rejection is respectfully traversed.

Claim 15, from which claim 16 depends, recites essentially the same subject matter recited in allowed claim 5. Specifically, claim 15 recites the subject matter that gave rise to the allowance of claim 5 as specified during the telephone interview on October 10, 2006.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 15 and 16 in paragraphs 12-17 on pages 5-7 of the Office Action be withdrawn.

In paragraphs 19-22 on pages 7-8, the Office Action rejects claim 12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,450,351 to Heddes. This rejection is respectfully traversed.

The Office Action correctly concedes that Heddes does not disclose, teach or suggest a combinatory logic means according to the combination recited in claim 12. In order to overcome this correctly conceded deficiency in Heddes, the Office Action asserts that one of ordinary skill

Application No: 10/733,343
Attorney's Docket No: ALC 3108

in the art would nevertheless have been motivated to implement a logic unit with combinatory logic.

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

"The factual inquiry whether to combine references must be thorough and searching." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). Here, it does not appear that the Examiner has conducted the requisite "thorough and searching" factual inquiry. Rather, the Examiner has made no indication whatsoever of where a teaching or suggestion appears in the prior art to result in the subject matter according to the combinations recited in the rejected claims. The "factual question of motivation [to combine references] is material to patentability, and [can] not be resolved on subjective belief and unknown authority." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Rather, it appears that the Examiner improperly relies on the Examiner's own "subjective belief and unknown authority" to establish the motivation essential to an obviousness inquiry by making an unsupported allegation regarding what would be within the knowledge of one having

Application No: 10/733,343
Attorney's Docket No: ALC 3108

an ordinary level of skill in the art at the time the application was filed. In other words, the Examiner attempts to substitute facts within the personal knowledge of the Examiner for a reference showing the asserted motivation. Applicant respectfully submits that this is improper for at least the following reasons.

According to 37 C.F.R. § 1.104(d)(2), discussed and cited in M.P.E.P. § 2144.03, the Examiner is required to submit an affidavit supporting the facts of which the Examiner relies upon within the Examiner's own knowledge, subject to contradiction or explanation by the Applicant and other persons. Applicant requests such an affidavit. If the Examiner is relying on personal knowledge regarding what would have been known by a person having an ordinary level of skill in the art at the time the application was filed outside of what is disclosed, taught and suggested by the applied reference, then Applicant requests that the affidavit specify the facts upon which that personal knowledge is based.

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to arrive at the subject matter according to the combinations recited in claim 12. Applicant further asserts that the Examiner's unsupported allegation of what would be known by a person having an ordinary level of skill in the art at the time the application was filed is a false substitute for this impermissible use of hindsight knowledge of Applicant's own disclosure.

For at least the foregoing reasons, it is respectfully requested that the rejection of claim 12 in paragraphs 12-19 on pages 7-8 of the Office Action be withdrawn.


Application No: 10/733,343
Attorney's Docket No: ALC 3108

CONCLUSION

While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the undersigned attorney in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
KRAMER & AMADO, P.C.



Terry W. Kramer
Registration No.: 41,541

Date: December 28, 2006

KRAMER & AMADO, P.C.
1725 Duke Street, Suite 240
Alexandria, VA 22314
Phone: 703-519-9801
Fax: 703-519-9802